



The new European patent landscape: State of play of the Unified Patent Court

Thursday, February 16, 2023 - Piazza Borromeo 12, Milan, Italy
Seminar 3:30 pm - 6 pm

Scope and framework of the UPC Rules of Procedure - Provisional measures: requirements, injunctions and corrective measure

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UNITARY PATENT SYSTEM

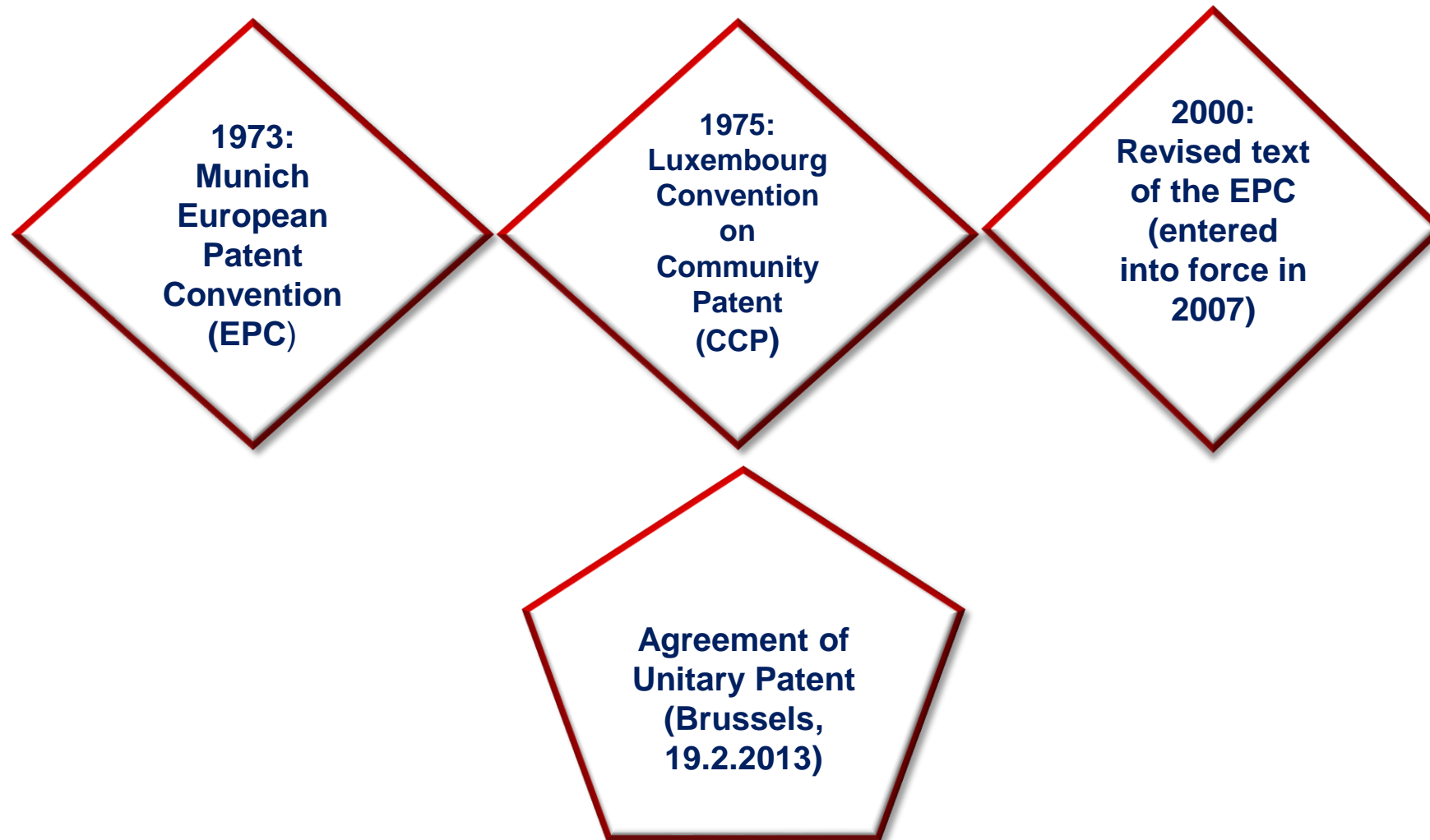
Unitary Patent Agreement,

Brussels, 19 February 2013,

today: 25 European countries

The Agreement has seen today the accession of 25 European countries, including Italy, (no United Kingdom, because of Brexit), excluding Poland Croatia and Spain, who have decided not to sign it.

➤ Historical evolution in the European context



➤ Historical evolution....more recently

- **5 July 2000, the Commission adopted a proposal for a Council Regulation on the Community patent for the creation of a unitary patent providing uniform protection throughout the Union**
- **30 June 2010, the Commission adopted a proposal for a Council Regulation on the translation arrangements for the European Union patent providing for the translation arrangements applicable to the European Union patent.**
- **10 November 2010 at the Council meeting, it was recorded that there was no unanimity to go ahead with the proposed Regulation on the translation arrangements (insurmountable difficulties)**
- **In these circumstances, 12 Member States addressed requests to the Commission by letters dated 7, 8 and 13 December 2010 indicating that they wished to establish enhanced cooperation (requests confirmed at the meeting of the Council on 10 December 2010).**
- **In the meantime, 13 more Member States have written to the Commission indicating that they also wish to participate in the envisaged enhanced cooperation. In total, 25 Member States have requested enhanced cooperation.**
- **EU Court of Justice (Grand Chamber) rejected the actions of Italy and Spain by judg. 16 April 2013, and again the Spain's action by judg. 5 May 2015**

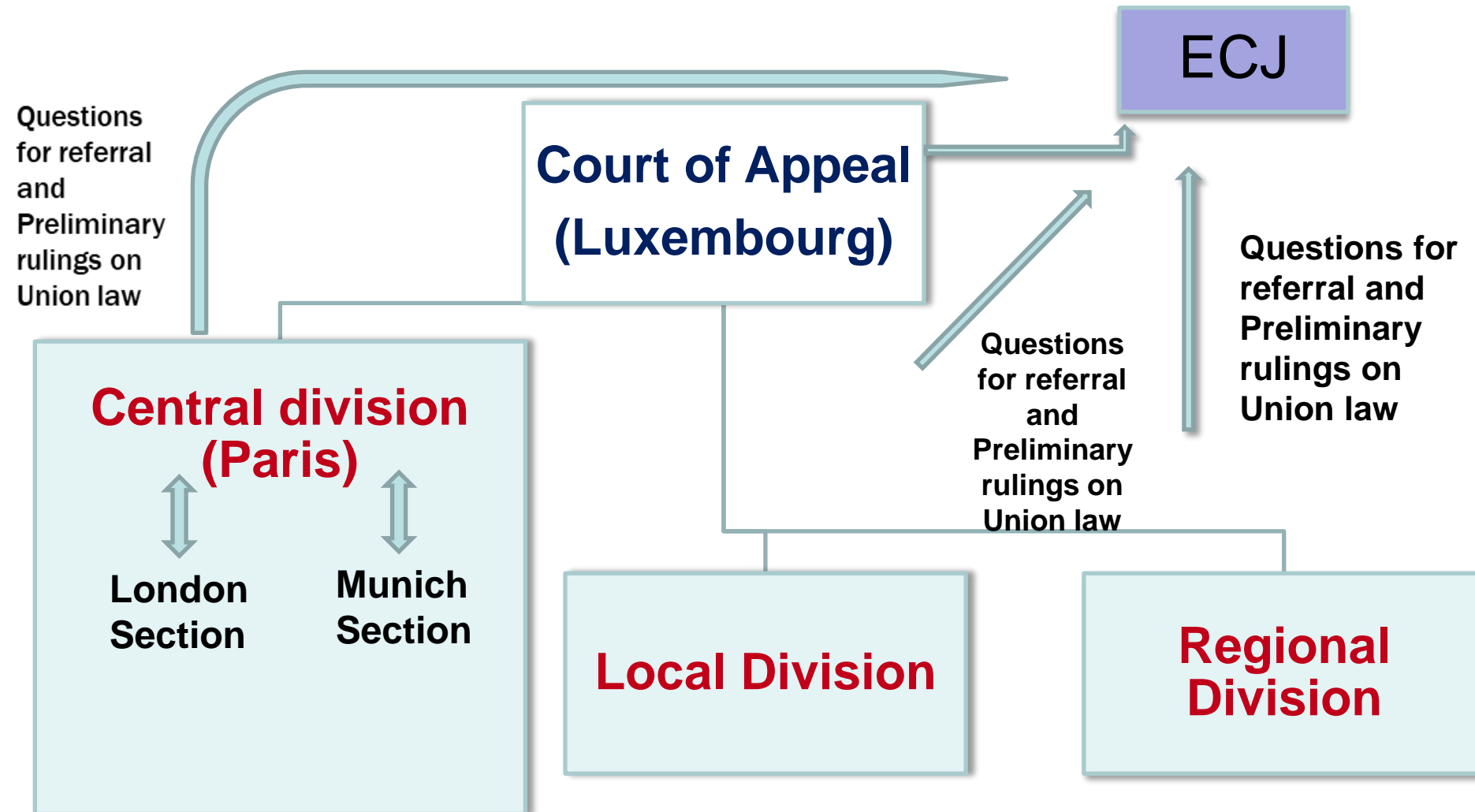
UNITARY PATENT SYSTEM (I)

- **The Unitary Patent will be “a European patent with unitary effect”. It will have uniform character throughout the territories of the 25 Member States.**
- **European patents will benefit from unitary effect at the request of the patentee**

- **This kind of patent will co-exist with**
 - **national patents and their protection systems,**
 - **traditional European Patents before national courts**
 - **traditional European Patents before the UPCs**
- **European Patents with Unitary Effect before the UPCs**

UNITARY PATENT SYSTEM (II)

- ▶ The Agreement sets up a system of **Unified Patent Courts** for litigation relating to the infringement and validity of patents.
- ▶ The UPCs should be devised to ensure expeditious and high quality decisions, striking a fair balance between the interests of right holders and other parties, taking into account the need for proportionality and flexibility.
- The UPC should be a Court common to the contracting Member States and thus part of their judicial system, with exclusive competence regarding:
 - ▶ European Patents with unitary effect and
 - ▶ European patents granted under the provisions of the pre-existing EPC.





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Competence of the Court

Art. 32 Agreement

- (1) The Court shall have exclusive competence in respect of:
- (a) actions for actual or threatened **infringements** of patents and supplementary protection certificates and related defenses, including counterclaims concerning licenses;
- (b) actions for declarations of **non-infringement** of patents and supplementary protection certificates;
- (c) **actions for provisional and protective measures and injunctions**;
- (d) actions for **revocation** of patents and for declaration of invalidity of supplementary protection certificates;
- (e) **counterclaims for revocation** of patents and for declaration of invalidity of supplementary protection certificates;
- (f) actions for **damages** or compensation derived from the provisional protection conferred by a published European patent application;
- (g) actions relating to the **use of the invention prior to the granting** of the patent or to the right based on prior use of the invention;
- (h) actions for **compensation for licenses** on the basis of Article 8 of Regulation (EU) No 1257/2012 (licences of right); and
- (i) actions concerning **decisions of the European Patent Office** in carrying out the tasks referred to in Article 9 of Regulation (EU) No 1257/2012.

Competence of the Divisions of the Court of First Instance

Art. 33 Agreement

- Actions for patent **infringement** and related defences,
- Actions for **provisional and protective measures and injunctions**,
- Actions for **damages** or compensation derived from provisional protection,
- Actions relating to **prior use**,
- **Counterclaims for revocation** in pending infringement cases.

Rules of Procedure Final text, July 8, 2022
(effective from September 1, 2022
(18th Draft July 1st, 2015 - 19th Draft February 25, 2016 –
***Rules on Court fees and recoverable costs*)**

- **Rules 1/382, organised in 6 parts (Chapters and Sections)**
- **With regards the first versions:**
 - **unification and numerical reduction of the rules (the draft of March 30, 2012, had 511 rules, that of May 31, 2013, had 382)**
 - **introduction of new provisions (rules 5 and 5A opt-out, rules 270/279 on the telematic process, section 6 re-establishment of rights, rule 362, absolute bar to proceeding with an action, for example because of the application of the principle of *res iudicata*)**
- **Rules find their source in the Agreement on a Unified Patent Court (OJEU 20.6.2013 C 175/12), Art. 41**

Rules of Procedure purpose and requirements

Art. 41, para. 3

▶ The RoP shall guarantee that:

- the decisions of the Court are of the highest quality,
- the proceedings are organised in the most efficient and cost effective manner,
- shall ensure a fair balance between the legitimate interests of all parties,
- shall provide for the required level of discretion of judges without impairing the predictability of proceedings for the parties

Provisional and Protective Measures (I)

(Articles 62-63 Agreement – rules 205/213 ROP, Part 3 + Part 2, Evidence, rules 192/201)

➤ **Injunctions – Penalty**

- **Cross border injunctions**
- **Dynamic injunctions**
- **Injunction gap**

➤ **Rules 192/198: Order on the Application for preserving evidence:**

- **preserving evidence by detailed description (samples),**
- **seizure of allegedly infringing goods,**
- **seizure of movable and immovable property (compensation for damages)**

➤ **Rule 200: Order to freeze assets**

- **blocking of bank accounts and/or other assets**

➤ **Rule 201: Experiments ordered by the Court**

Provisional and Protective Measures (II)

(Articles 62-63 Agreement – rules 205/213 ROP, Part 3
+ Part 2, Evidence, rules 192/201)

➤ **Requirements:**

- *fumus boni iuris*, the applicant must provide sufficient evidence (reasonable evidence, reasonably available and plausible evidence) that he/she is the holder of the rights and
- *periculum in mora*, that the rights are subject to prejudice or are threatened by imminent prejudice

➤ **The Court must at its discretion assess the balance of opposing interests**

➤ **Procedure: reference to par. 5/9 Art. 60 (order to preserve evidence and inspections); rules 192/198 shall apply *mutatis mutandis***

Provisional and Protective Measures (III)

**(Articles 62 and 60(5) to (9) Agreement - Art. 19 (3) Statute –
Rules 40, 205 et s.)**

- **Double phase: written and oral phase.**
- **Written phase: two different ways to hinge the action.**
 - **1) the applicant files a written brief with his/her precautionary requests, accompanied by the relative documentation (rule 206)**
 - **2) anyone who fears being subject to precautionary proceedings can send a protective letter in advance, specifying his/her defences. If the precautionary action is not brought within six months, the protective letter loses effect (rule 207)**
 - **Art. 19 para. 3 Statute: a judge permanently destined to deal with urgent cases can be designated for each division**

Provisional and Protective Measures (IV)

- **Rule 205: summary proceedings,**
 - (a) written procedure
 - (b) oral procedure, which may include an oral hearing of the parties or of one of the parties (also *inaudita altera parte*),
- **Rule 206, the Application may be lodged before or after main proceedings on the merits of the case have been started before the Court**
 - para 2, the Application shall contain:
 - (c) the reasons why provisional measures are necessary to prevent a threatened infringement, to forbid the continuation of an alleged infringement or to make such continuation subject to the lodging of guarantees,
 - (d) facts and evidence,
 - (e) a concise description of the action which will be started before the Court (main proceedings on the merits),
- **para. 3 inaudita altera parte Where the applicant requests that provisional measures be ordered without hearing the other party (the defendant), the Application for provisional measures shall in addition contain:**
 - (a) the reasons for not hearing the defendant having regard in particular to Rule 197;
 - (b) information about any prior correspondence between the parties concerning the alleged infringement

Provisional and Protective Measures – Revocation – Appeal

➤ Rule 213, Revocation

Para 1: The Court shall ensure that provisional measures are revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if, within a time period not exceeding 31 calendar days or 20 working days, whichever is the longer, from the date specified in the Court's order, the applicant does not start proceedings on the merits of the case before the Court

Para 2: Where provisional measures are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of the patent, the Court may order the applicant, upon request of the defendant, to provide the defendant with appropriate compensation for any injury caused by those measures

Appeal

➤ Part 4 - Procedure before the Court of Appeal,

➤ Rule 220 - Appealable decisions: ...

(c) orders referred to in Articles ...60, 61, 62 or 67 of the Agreement appealable without waiting for the appeal against the final decision and without the leave of the Court of First Instance

Milan – UPC Local Division



Thank you for your kind attention!



UPC Milan Local Division
MAIN ENTRANCE - via San Barnaba 50